

Appln. No. 10/076,563

Amendment dated April 26, 2005

Reply to Office Action mailed January 26, 2005

### REMARKS

Reconsideration is respectfully requested.

Claims 1 through 20 remain in this application.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### Paragraph 1 of the Office Action

Claims 1-9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Yagi (US 6,725,020) in view of Garfinkel (US 6,157,298) and further in view of Gardner (GB 2,290,696).

In regard to claim 1, it is submitted that the combination of Yagi with Garfinkel and Gardner is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a playing assembly being positioned in said perimeter wall of said helmet, said playing assembly being adapted for reading audio information from a compact disc". The Yagi reference fails to teach the playing assembly being positioned in the perimeter wall of the helmet and that the playing assembly reading audio information from a compact disc as claimed by the applicant. Further, the Yagi reference teaches away from that claimed by the applicant in that the Yagi reference teaches the control panel positioned on the tank of the motorcycle and transmitting the information to the communication system within the helmet to transfer the information to the user via the speaker in the helmet. The Garfinkel reference fails to teach the playing assembly being positioned in the perimeter wall of the helmet and that the playing assembly reading audio information from a compact disc as claimed by the applicant. Again, the reference cited receives signals and from a remote source and transfers the information to the user through speakers that are suspended from the helmet. The Office Action uses the Gardner reference in an

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attempt to meet the requirement of the claims by introducing the headgear having the ability to used with a compact disc player instead of the standard audio cassette player when there is a complete lack of motivation for such a combination to made with the Yagi and Garfinkel references when they both receive audio information transmitted from a remote location. The only motivation that can be found for such a combination is the improper use of the applicant's claim in hindsight. It is respectfully submitted that the Examiner has improperly used applicant's claim 1 as a recipe for selecting and combining isolated elements of various references and has used the benefits achieved by applicant's claimed structure--benefits described only in applicant's disclosure--in hindsight as the motivation for making the asserted combination of references.

Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (PTO Bd. App. 1985).

Therefore, it is submitted that the combination of the Yagi reference with the Garfinkel and Gardner references would not lead one to the combination of features as claimed by the applicant.

Withdrawal of the §103(a) rejection of claims 1-9 is therefore respectfully requested.

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**Paragraph 2 of the Office Action**

Claims 10 and 11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Yagi (US 6,725,020) in view of Garfinkel (US 6,157,298), Gardner (GB 2,290,696) and further in view of Comparetto (US 4,663,785).

In regard to claim 1, it is submitted that the combination of Yagi with Garfinkel, Gardner and Comparetto is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a playing assembly being positioned in said perimeter wall of said helmet, said playing assembly being adapted for reading audio information from a compact disc". As discussed above, There is a lack of motivation for the combination of the Yagi, Garfinkel and Gardner references and the only motivation that can be found for such a combination is the improper use of the applicant's claim in hindsight. Further, the Comparetto reference additionally provides an head protector that receives information from a remote location and transfers that information to the user through speakers in the protector. Thus, it is respectfully submitted that the Examiner has improperly used applicant's claim 1 as a recipe for selecting and combining isolated elements of various references and has used the benefits achieved by applicant's claimed structure--benefits described only in applicant's disclosure--in hindsight as the motivation for making the asserted combination of references.

Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to

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say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (PTO Bd. App. 1985).

Therefore, it is submitted that the combination of the Yagi reference with the Garfinkel and Gardner and Comparetto references would not lead one to the combination of features as claimed by the applicant.

It is further submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance four references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as two other references should be combined with the potential primary reference.

Withdrawal of the §103(a) rejection of claims 10 and 11 is therefore respectfully requested.

### Paragraph 3 of the Office Action

Claims 12-20 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Yagi (US 6,725,020) in view of Garfinkel (US 6,157,298), Gardner (GB 2,290,696) and further in view of Comparetto (US 4,663,785).

In regard to claims 12 and 13, it is submitted that the combination of Yagi with Garfinkel and Gardner is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the

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combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a playing assembly being positioned in said perimeter wall of said helmet, said playing assembly being adapted for reading audio information from a compact disc". The Yagi reference fails to teach the playing assembly being positioned in the perimeter wall of the helmet and that the playing assembly reading audio information from a compact disc as claimed by the applicant. Further, the Yagi reference teaches away from that claimed by the applicant in that the Yagi reference teaches the control panel positioned on the tank of the motorcycle and transmitting the information to the communication system within the helmet to transfer the information to the user via the speaker in the helmet. The Garfinkel reference fails to teach the playing assembly being positioned in the perimeter wall of the helmet and that the playing assembly reading audio information from a compact disc as claimed by the applicant. Again, the reference cited receives signals and from a remote source and transfers the information to the user through speakers that are suspended from the helmet. The Office Action uses the Gardner reference in an attempt to meet the requirement of the claims by introducing the headgear having the ability to used with a compact disc player instead of the standard audio cassette player when there is a complete lack of motivation for such a combination to made with the Yagi and Garfinkel references when they both receive audio information transmitted from a remote location. Further, the Comparetto reference additionally provides an head protector that receives information from a remote location and transfers that information to the user through speakers in the protector. The only motivation that can be found for such a combination is the improper use of the applicant's claim in hindsight. It is respectfully submitted that the Examiner has improperly used applicant's claims 12 and 13 as a recipe for selecting and combining isolated elements of various references and has used the benefits achieved by applicant's claimed structure--benefits

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described only in applicant's disclosure--in hindsight as the motivation for making the asserted combination of references.

Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

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Therefore, it is submitted that the combination of the Yagi reference with the Garfinkel, Gardner and Comparetto references would not lead one to the combination of features as claimed by the applicant.

It is further submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance four references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as two other references should be combined with the potential primary reference.

Withdrawal of the §103(a) rejection of claims 12-20 is therefore respectfully requested.

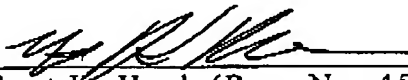
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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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